

REMARKS

Claims 1-21 are pending in the application. Please amend claims 9 and 21 as specified above. In view of the following considerations, claims 1-21 are believed to be allowable.

I. OBJECTION TO DRAWINGS

The drawings of the present application were objected to because they did not show a "fractional sampling rate converter unit." However, Fig. 1 clearly shows a fractional sampling rate converter unit represented by numeral 2. Textual support for this proposition is found in the originally filed specification, for example, on page 11a, lines 2-3. Thus, the Applicants believe the drawings as filed meet the formal requirements.

II. OBJECTION TO CLAIM 21

Claim 21 was objected to because of the terms "UMTS" and "GMS" were not spelled out. The above amendment clarifies these terms.

III. REJECTION OF CLAIM 9 UNDER 35 U.S.C. § 112

Claim 9 was rejected as being indefinite because the terms "the time duration" and "the conversion ratio" lacked antecedent basis. The above amendment clarifies these terms.

IV. REJECTION OF CLAIMS 1 AND 5 UNDER 35 U.S.C. § 103(a)

Pending claims 1-2, 4-6, and 8-21 were rejected under 35 U.S.C. § 103(a) in view of U.S. Publication 2004/0152438 (Yamauchi) and U.S. Patent No. 5,920,557 (Hirata). Further, claims 3 and 7 were rejected under 35 U.S.C. § 103(a) in view of Yamauchi and Hirata, and further in view of U.S. Publication 20043/0174757 (Partyka). Withdrawal of these rejections is respectfully requested for at least the following reasons.

- i. The present application is entitled to a priority date of 3/25/02, and as such Yamauchi, which is the primary reference, is not available prior art under 35 U.S.C. § 103(a).*

The present application is entitled to benefit from the filing date of the prior foreign application (German Patent Application Serial No. 102 13 262.3, which was filed on March 25, 2002), and a copy of the English translation of the priority document, along with a statement of translation accuracy is attached with this response. See MPEP § 201.15. Thus, in order to be available as a reference under §103, Yamauchi must have an effective date that is earlier than that of the present application (3/25/02).

In determining whether Yamauchi is available as 102(e) type prior art, it is important to note that Yamauchi was published under PCT Article 21(2) *in Japanese* on 5/12/02. See Appendix I. "According to 102(e), no benefit of the international filing date . . . is given for § 102(e) prior art purposes if the [International Application] was published under PCT Article 21(2) by WIPO, *in a language other than English* regardless of whether the international application entered the National Stage." *United States Patent and Trademark Office OG Notices: 14 January 2003* (quoting Example 5, emphasis added) (full OG Notice available at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/102eog121102.pdf>).

USPTO examination guidelines provide an example that squares precisely with the present case. The text of this example is reproduced below, and a full printout, including graphical timelines, can be found in Appendix II (page 13 thereof):

[A]n international application (IA) was filed, US designated on January 1, 2001; the international application publication by WIPO not in English was on July 1, 2002; the §371(c)(1)(2) and (4) fulfillment [sic] date is June 1, 2003; a publication by the USPTO under § 122(b) was on October 2, 2003 and a patent was granted on §371 application on November 2, 2004.

The §102 (e)(1) date for the IA publication by WIPO is: None
The §102(e)(1) date for Publication by USPTO is: None.
The §102(e)(2) date for the Patent is: None

The IA publication by WIPO can be applied under §102(a) or (b) as of its publication date (01 July 2002).

Id. (quoting Example 5, emphasis added). ***Thus, because Yamauchi was published as a PCT publication in a language other than English, the Yamauchi U.S. publication is not entitled to a prior art date of March 15, 2002 under § 102(e).***

Therefore, the Yamauchi U.S. publication has an effective date only under §102(a) or § 102(b), (*i.e.*, 8/5/04), which makes it unavailable as prior art in the present instance.

Further, even though the U.S. published application to Yamauchi (2004/0152438) has other family members (*e.g.*, PCT Publication No. WO02098023 A1 (published 12/5/02), Japanese Publication No. JP2002353875 A (published 12/6/02)), the Applicants believe these references are similarly unavailable as prior art under § 103 because they were published after the effective date of the present application. In addition, these family members were published in a language other than English.

As Yamauchi was the primary reference, the remaining prior art of record fails to disclose numerous elements of independent claims 1 and 9, from which the remainder of the claims depend. Thus, as neither claim 1 nor claim 9 is rendered obvious by the available prior art of record, withdrawal of all rejections is respectfully requested.

IV. CONCLUSION


For at least the above reasons, pending claims currently under consideration are believed to be in condition for allowance and notice thereof is requested.

Should the Examiner feel that a telephone interview would be helpful to facilitate favorable prosecution of the above-identified application, the Examiner is invited to contact the undersigned at the telephone number provided below.

In addition, should any fees be due as a result of the filing of this response, the Commissioner is hereby authorized to charge the Deposit Account Number 50-1733, LLP141WOUS.

Respectfully submitted,
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By



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CERTIFICATE OF MAILING (37 CFR 1.8a)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: June 30, 2006


Christine Gillroy